

REMARKS

Applicant respectfully requests reconsideration of the present case in view of the above amendments and the following remarks.

As a preliminary matter, Applicants note that they did not “agree” that the restriction requirement did not include an election of species, but rather acknowledged this and, for purposes of advancing prosecution, elected the glycosidase enzyme of Group A.

Claims 37, 39, 53, and 58 have been canceled. Claims 33, 38, 41, 50-52, and 54 have been amended. Claims 33-36, 38, 40-52, and 54-57 are currently pending.

No new matter has been inserted. Support for the amendment of claim 33 can be found in the specification at page 3, line 18, page 5, lines 6-8, and claim 37. Claim 38 was simply amended to change its dependency. Support for the amendment of claims 41 and 54 can be found in the specification at least at page 10, line 1. Support for the amendment of claim 50 can be found in the specification at page 3, line 18. Claim 51-52 were simply amended to correct typographical errors.

Claim 39 was objected to because it includes independent and/or distinct compositions drawn to non-elected inventions. While not conceding the correctness of Examiner’s position, Applicant has canceled claim 39 without prejudice or disclaimer. Claim 53 was also canceled without prejudice as drawn to a non-elected invention.

Claim 33 was objected to for a misspelling. Claim 33 has been amended to correct this typographical error.

35 U.S.C. § 112, second paragraph

Claims 41 and 54 were rejected under 35 U.S.C. § 112, second paragraph, for containing the trademark/tradename Triton X®-100. Applicant respectfully traverses this rejection.

While not conceding the correctness of Examiner’s position, in the interest of advancing prosecution, Applicant has amended claims 41 and 54 to eliminate the term “Triton X®-100”. Applicant respectfully requests that this rejection be withdrawn.

35 U.S.C. § 112, first paragraph

Claims 33-52 and 54-57 were rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. Applicant respectfully traverses this rejection.

Specifically, the Examiner states that the specification does not reasonably provide enablement for the claims as broadly drawn. The Examiner asserts that the claims are broadly drawn to a method of alleviating or curing prostate cancer, and that they further encompass preventing cancer.

In response, Applicant notes that claims 33 and 50 are drawn specifically to an effect on “a prostate tumor.” Therefore, the Examiner’s comments regarding curing or preventing prostate “cancer” are inapplicable. In order to enable the scope of the claims, Applicant only needs to enable the degradation of a prostate tumor, not the prevention or curing of “metastatic” prostate cancer. Accordingly, Examiner’s statements regarding the predictability of preventing or curing “metastatic” prostate cancer in patients and “a complete cure” are now inapplicable.

To clarify this point, while not narrowing the claims, the Applicant has amended claims 33 and 50 to eliminate the terms “alleviating or curing” and instead include the term “degrading.” Applicant submits that it is now clear that the claims are fully enabled.

The Examiner further states that with regards to the therapeutic composition, the specification teaches that an effective concentration of hyaluronidase is added in addition to collagenase for the treatment of localized prostate cancer. However, the Examiner states that it would not be predictable that any other compositions would effectively substitute for the successful combination of hyaluronidase and collagenase.

In response, while not conceding the correctness of Examiner’s position, Applicant has amended claim 33 to include both hyaluronidase and collagenase, in order to obviate this rejection. For at least these reasons, Applicant respectfully requests that this rejection be withdrawn.

Double Patenting

Claims 33, 35-37, 39-52, and 54-57 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,428,785. Applicant respectfully traverses this rejection.

Applicant respectfully requests that the Examiner hold this rejection in abeyance until the claims are otherwise found to be in condition for allowance.

Summary

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully Submitted,

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